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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,009	10/31/2003	Masao Hamada	H07-162738M/MNN	8243
21254	7590	03/08/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			CHUKWURAH, NATHANIEL C	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,009	<b>Applicant(s)</b> HAMADA ET AL.	
	<b>Examiner</b> Nathaniel C. Chukwurah	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 15-22 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>1/10/2005</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.   |

### **DETAILED ACTION**

Newly submitted claims 4-10 and 11-14 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I, a box nailing machine and II, a magazine are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as magazine used in other nailing machine than box nailing machine. See MPEP § 806.05(d).

Inventions I, II, apparatus and III, method of manufacturing a magazine are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be used to manufacture a tool than a magazine. The subcombinations and a method of manufacturing a magazine were not originally presented.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-14 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

Figures 1-7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37

Art Unit: 3721

CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 15-22 are rejected under 35 U.S.C. 102(b) as being anticipated by

Applicant's Admitted Prior Art.

With regard to claim 1, Applicant's Admitted Prior Art (see figs. 1-7 and pages 1-3 of the specification) discloses a box nailing machine comprising: a body (1), a nail driving port (2), a handle portion (3) comprising a handle arm (4), a U-shaped metal magazine (5), a forward end portion (proximal end) attached to drive port (2), a portion of magazine (see fig. 4) attached to the handle portion (3) via handle arm (4), a handle arm attaching portion (12), a washer (9) integrally formed in the handle arm attaching portion (12), wherein the washer is disposed between a head portion of a fixing bolt and the magazine (see fig. 5).

Art Unit: 3721

With regard to claim 2, Applicant's Admitted Prior Art shows handle arm attaching portion protrude towards the handle arm (see fig. 5); and opening portion (fig. 5) larger than an outer dimension of the fixing bolt (7).

With regard to claim 3, Applicant's Admitted Prior Art shows the protruding size of the handle arm attaching portion is larger than the head portion of the bolt (see fig. 5).

With regard to claim 15, Applicant's Admitted Prior Art shows a box nailing machine comprising: a body (1), a nail driving port (2), a handle portion (3) comprising a handle arm (4), a U-shaped magazine (5), a forward end portion (proximal end) attached to drive port (2), a washer (9) fixed to an inner wall of the handle arm attaching part (12).

With regard to claim 16, Applicant's Admitted Prior Art shows a press-formed metal plate (10).

With regard to claim 17, Applicant's Admitted Prior Art shows handle arm attaching portion protrude towards the handle arm (see fig. 5).

With regard to claim 18, Applicant's Admitted Prior Art shows handle arm attaching portion protrude towards the handle arm (see fig. 5) by a distance larger the height of the head of the fastener.

With regard to claim 19, Applicant's Admitted Prior Art shows a U-shaped magazine attached to the handle arm with a fastener (7, 8).

With regard to claim 20, Applicant's Admitted Prior Art shows a screw and bolt (7, 8).

With regard to claim 21, Applicant's Admitted Prior Art shows opening opposed to the handle arm attaching part (fig. 5) larger than head of the fastener (7, 8).

Art Unit: 3721

With regard to claim 22, Applicant's Admitted Prior Art shows washer (9) fixed to the inner wall by at least one of caulking, welding, soldering, and adhering (see fig. 5).

***Allowable Subject Matter***

Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to disclose or suggest a slot that receives V-shaped notch in washer.

***Response to Arguments***

Applicant's arguments with respect to claims 1-3 and 15-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (571) 272-4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

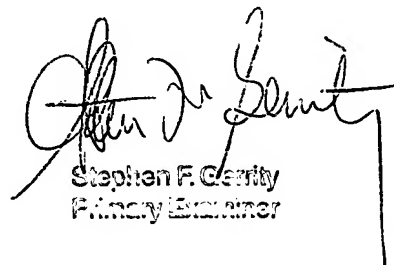
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NC

February 23, 2005



Stephen F. Garity  
Primary Examiner